

REMARKS

Claims 1-14 are in this application, of which Claims 1, 6-8, 12-14 are in independent form, and of which Claims 5 and 8-14 have been withdrawn from consideration. Favorable reconsideration is respectfully requested.

Initially, Applicant respectfully traverses the statement in the outstanding Office Action that Claim 14 is not generic to the two Species identified in the election-of-species requirement imposed by the Examiner in the Office Action dated January 10, 2006. The Office Action states that Claim 14 contains requirements (limitations) not found in Claim 13 (one of the claims directed to the non-elected Species), and notes that examination of Claim 14 would require examination of limitations that belong to the non-elected Species. This last observation is correct, in that Claim 14 adopts the Markush style of claiming, discussed in the MPEP:

“A Markush-type claim recites alternatives in a format such as ‘selected from the group consisting of A, B and C.’ See *Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925). The members of the Markush group (A, B, and C in the example above) ordinarily must belong to a recognized physical or chemical class or to an art-recognized class. However, when the Markush group occurs in a claim reciting a process or a combination (not a single compound), it is sufficient if the members of the group are disclosed in the specification to possess at least one property in common which is mainly responsible for their function in the claimed relationship, and it is clear from their very nature or from the prior art that all of them possess this property. Inventions in metallurgy, refractories, ceramics, pharmacy, pharmacology and biology are most frequently claimed under the Markush formula but purely mechanical features or process steps may also be claimed by using the Markush style of claiming. See MPEP § 2173.05(h).“ MPEP § 803.02.

Applicant believes that Claim 14 should be examined as to the elected species, and beyond that as far as necessary to determine the allowability of that claim:

“If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made

without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits, even though they may be directed to independent and distinct inventions. In such a case, the examiner will not follow the procedure described below and will not require provisional election of a single species. >See MPEP § 808.02.<

* * *

This subsection deals with Markush-type generic claims which recite a plurality of alternatively usable substances or members. In most cases, a recitation by enumeration is used because there is no appropriate or true generic language. A Markush-type claim may include independent and distinct inventions. This is true where two or more of the members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C. 103 with respect to the other member(s). In applications containing a Markush-type claim that encompasses at least two independent or distinct inventions, the examiner may require a provisional election of a single species prior to examination on the merits. An examiner should set forth a requirement for election of a single disclosed species in a Markush-type claim using form paragraph 8.01 when claims limited to species are present or using form paragraph 8.02 when no species claims are present. See MPEP § 808.01(a) and § 809.02(a). Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the Markush-type claim is not allowable **, the provisional election will be given effect and examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration.” *Ibid.*

Accordingly, Applicants submit that Claim 14 is a proper generic claim, and should be examined in the fashion and to the extent indicated in the MPEP.

In the outstanding Office Action, Claims 1, 3 and 4 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,035,103 (Zuber), and Claims 2, 6 and 7 were rejected under 35 U.S.C. § 103(a) as being obvious from *Zuber*

According to the aspects of the present invention to which independent Claims 1, 6 and 7 are respectively directed, it is possible to achieve high-quality image processing (although it takes more time) by using the first mode, executing development a number of times according to the output devices (lines 4-25 of page 28 in the originally

filed specification), and it is also possible to achieve high-speed image processing, although with lower image quality, by using the second mode, executing one-time development (page 28, line 26, to page 30, line 14, in the originally filed specification).^{1/}

Thus, according to these aspects of the invention, it is possible to provide these two kinds of modes, whereby a user can freely and effectively select either one of the high-quality image process and the high-speed image process.

As Applicant reads *Zuber*, that patent does contemplate two modes of operation identified at col. 18, lines 5-30, which differ in that in one mode, an entire print job is rasterized, stored on disk and then sent to a recording engine (lines 12-16), which is suitable for slower recording engines and when rasterized data needs to be saved on disk for later (re)use (this is what the Office Action refers to as the “preferred” mode). In the other, rasterized pages are passed to the print engines at the same time as they are written to disk (the “writethrough” mode; lines 27-31).

Nothing in *Zuber* indicates that these modes differ at all as to any parameter used to govern color processing, however. A technique is cited in the Office Action for generating an average parameter taken from the average of values of several of the printer engines, while omitting that of an engine whose operation appears to be relatively aberrant (col. 35, line 50, through col. 36, line 56). Applicant notes however that that technique is used to overcome the problem posed by the presence of such an aberrancy in a case in which multiple engines are being used on the same print job and one has a dot-linearization curve that is excessively different from those of the other engines. This permits the RIP

^{1/} It is of course to be understood that the claim scope is not limited by the details of this or any other particular embodiment that may be referred to.

software engine to store a single curve (the average) and use it with the plural engines while still having the possibility of obtaining an acceptable output. In contrast, simply using the curve of one engine for all the engines, is apt to produce a significant and undesirable gray shift (col. 35, lines 8-11).

The portion of *Zuber* cited by the Examiner as teaching the first mode recited in the claims, moreover, observes that engines in fact differ slightly from each other in color space, and even from other engines of the same model. *Zuber* does not consider it practical to compensate for these differences, unless perhaps by means of the manufacturer defining the color profiles of the individual engines (col. 30, lines 16-20).

Applicant does not follow the reasoning by which the Examiner concludes that it would have been obvious to adopt these two techniques of defining color processing as two modes of operation in a single apparatus, as recited in the present claims. The two modes mentioned in *Zuber*, and cited by the Examiner, differ in the timing at which rasterized data is output and where that data is sent, not in the color processing or in the dot linearization.

Moreover, it is not clear why the Examiner considers the color-profile matching discussed at col. 30 and the dot linearization discussed at col. 35 to be interchangeable techniques. Even if col. 30 of *Zuber* is taken as suggesting that a manufacturer actually specify such color-profile definitions, Applicant has found nothing in that patent that would suggest that it would be desirable to provide an apparatus operable in two separate modes, one using pre-defined color-processing definitions for each respective engine and the other using an optional definition.

Thus, it is believed that the invention is not taught or suggested by *Zuber*, and that independent Claims 1, 6 and 7 should be allowed promptly.

One of Applicant's attorneys will contact the Examiner by telephone shortly to finalize a time for an interview.

A review of the other art of record has failed to reveal anything which, in Applicant's opinion, would remedy the deficiencies of the art discussed above, as a reference against the independent claims herein. Those claims are therefore believed patentable over the art of record.

The other claims under rejection in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and allowance of the present application.

Applicant's undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

/Leonard P Diana/
Leonard P. Diana
Attorney for Applicant
Registration No. 29,296

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200

NY_MAIN 575312v1